

## II. REMARKS

### Formal Matters

Claims 1-29 and 66 are pending after entry of the amendments set forth herein.

Claims 15-21 were examined and were rejected. The Office Action stated that claims 22-65 were withdrawn from consideration. Applicants note that claims 30-65 were canceled without prejudice to renewal in a Preliminary Amendment, filed June 26, 2002.

Claims 15, 17, and 18 are amended. The amendments to the claims were made solely in the interest of expediting prosecution, and are not to be construed as acquiescence to any objection or rejection of any claim. Support for the amendments to claims 15, 17, and 18 is found in the claims as originally filed, and throughout the specification, in particular at the following exemplary locations: claim 15: page 9, lines 8-24; claim 17: page 9, lines 8-24; claim 18: page 9, lines 8-24. Accordingly, no new matter is added by these amendments.

Claim 66 is added. Support for new claim 66 is found in the claims as originally filed, and throughout the specification, including the following exemplary location: page 41, lines 10-21. Accordingly, no new matter is added by new claim 66.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

### Claim objections

Claims 15 and 17 were objected to.

The Office Action stated that claim 15 recites “said method”; and stated that there is no antecedent basis for “said method.”

Claim 15 is amended to recite “said assay comprising” instead of “said assay comprising.”

The Office Action stated that claim 17 recites “DGAT polypeptide is a human DGAT,” while claim 18 recites “said DGAT polypeptide is mouse DGAT.”

Claims 17 and 18 are amended such that they no longer recite “mouse DGAT” or “human DGAT.”

The above remarks adequately address the claim objections.

Rejections under 35 U.S.C. §112, first paragraph

Claims 15-21 were rejected under 35 U.S.C. §112, first paragraph as allegedly failing to meet the written description requirement. Claims 15-21 were rejected under 35 U.S.C. §112, first paragraph as allegedly lacking enablement.

Written description

The Office Action stated that the specification provides only a single representative species: human DGAT polypeptide, comprising the amino acid sequence of SEQ ID NO:5. The Office Action stated that the specification fails to describe additional representative species. Applicants respectfully traverse the rejection.

The specification describes a number of species of DGAT polypeptides. For example, the specification provides the amino acid sequence of a human DGAT polypeptide comprising the amino acid sequence set forth in SEQ ID NO:6; a mouse DGAT polypeptide comprising the amino acid sequence set forth in SEQ ID NO:7; and a plant DGAT polypeptide comprising the amino acid sequence set forth in SEQ ID NO:10. Specification, page 9, lines 8-24. Thus, in addition to SEQ ID NO:5, the specification provides at least three additional DGAT amino acid sequences. Accordingly, claims 15-21 meet the written description requirement of 35 U.S.C. §112, first paragraph.

Enablement

The Office Action stated that the disclosure is limited to those methods of use of the DGAT polypeptide having the amino acid sequence of SEQ ID NO:5. Applicants respectfully traverse the rejection.

As noted above, The specification describes a number of species of DGAT polypeptides. For example, the specification provides the amino acid sequence of a human DGAT polypeptide comprising the amino acid sequence set forth in SEQ ID NO:6; a mouse DGAT polypeptide comprising the amino acid sequence set forth in SEQ ID NO:7; and a plant DGAT polypeptide comprising the amino acid sequence set forth in SEQ ID NO:10. Specification, page 9, lines 8-24. Thus, in addition to SEQ ID NO:5, the specification provides at least three additional DGAT amino acid sequences.

Furthermore, the specification teaches how to determine whether an agent modulates DGAT activity. The specification provides a description of how to carry out a claimed screening assay. Specification, page 21, line 18 to page 23, line 9. The specification provides a working example of how

to measure DGAT activity. Specification, page 41, lines 10-21.

Given the guidance provided in the specification, combined with the knowledge in the art, those skilled in the art could carry out the claimed screening assay without undue experimentation.

Nevertheless, and solely in the interest of expediting prosecution, claim 15 is amended to recite that the DGAT polypeptide comprises an amino acid sequence having at least 90% amino acid sequence identity to the amino acid sequence set forth in SEQ ID NO:6.

Conclusion as to the rejections under 35 U.S.C. §112, first paragraph

Applicants submit that the rejection of claims 15-21 under 35 U.S.C. §112, first paragraph, has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.

Rejection under 35 U.S.C. §102(b)

Claims 15, 16, and 19 were rejected under 35 U.S.C. §102(b) as allegedly anticipated by Tabatan et al. ((1997) *Phytochemistry* 46:683-687; “Tabatan”).

The Office Action stated that Tabatan teaches a screening assay comprising contacting a DGAT polypeptide with a candidate agent, xanthohumol, and detecting a change in the activity of the DGAT polypeptide compared to a control.

Claim 15 as amended recites that the DGAT polypeptide comprises an amino acid sequence having at least 90% amino acid sequence identity to the amino acid sequence set forth in SEQ ID NO:6. SEQ ID NO:6 provides an amino acid sequence of a human DGAT. Tabatan discusses rat liver DGAT. Rat DGAT and human DGAT share only about 85% amino acid sequence identity. Tabatan neither discloses nor suggests a screening assay to determine a candidate agent’s DGAT modulatory activity, the method comprising contacting a candidate agent with a DGAT polypeptide, where the DGAT polypeptide comprises an amino acid sequence having at least 90% amino acid sequence identity to the amino acid sequence set forth in SEQ ID NO:6. Accordingly, Tabatan cannot anticipate claims 15, 16, and 19.

Applicants submit that the rejection of claims 15, 16, and 19 under 35 U.S.C. §102(b) has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.


### III. CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number UCAL-105 CIP2.

Respectfully submitted,  
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